

FEB 06 2007

ATTORNEY DOCKET NO. PRES06-00217
U.S. SERIAL NO. 09/940,722
PATENT**REMARKS BEST AVAILABLE COPY**

Claims 1 and 61–106 are pending in the present application.

Claims 1, 61, 80 and 94 were amended herein.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1, 61–68, 70, 74–88, 90, 94–101 and 103 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,354,331 to *Schachar*. This rejection is respectfully traversed.

A claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 at p. 2100-67 (8th ed. rev. 5 August 2006).

Independent claim 1 recites that the elongated body is adapted to be implanted in a pocket formed within the scleral tissue in the zone exterior to the ciliary body, the pocket having a length less than a circumference of the globe of the eye in that zone, and that the body and any members within the body that are attached to the body have an aggregate length less than the circumference of the globe of the eye in that zone. Such a feature is not found in the cited reference. The scleral band in *Schachar* extends around the entire circumference of the globe of the eye. Even the embodiment formed from a plurality of parts forms a continuous band extending around the entire circumference of the globe of the eye.

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Independent claim 61 recites that the first end of the body is linearly more distal from the second end than from any other portion of the body, and that the first and second ends are unattached to any other member. Similarly independent claim 74 recites that every portion of the body is spaced apart from the first end by a linear distance less than a linear distance between the first and second ends, and that the first and second ends are unattached to any other member. Such features are not found in the cited reference. The embodiment of the continuous band in *Schachar* formed from a looped strip of material with overlapping ends does not have ends separated by a linear distance greater than the linear distance between an end and any other part of the looped strip. The embodiment of the continuous band in *Schachar* formed from a plurality of segments does not have ends that are unattached to any other member.

Independent claim 80 recites a ridge extending along a majority of a length of the body from the first end to the second end. Such a feature is not found in the cited reference. *Schachar* does not teach that either the screw or the threads therein extend along a majority of a length of the continuous band.

Independent claim 94 recites that the ridge member is on the outer major surface of the body and along the major dimension. Such a feature is not found in the cited reference. *Schachar* does not disclose how the screw or threads are disposed relative to the strip of material forming the continuous band.

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Therefore, the rejection of claims 1, 61-68, 70, 74-88, 90, 94-101 and 103 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 61-70, 74-79, 89 and 102 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schachar*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5 August 2006). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

As noted above, the independent claims 61 and 80, from which the rejected claims depend, each recite features not found in the cited reference.

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Therefore, the rejection of claims 61–70, 74–79, 89 and 102 under 35 U.S.C. § 103 has been overcome.

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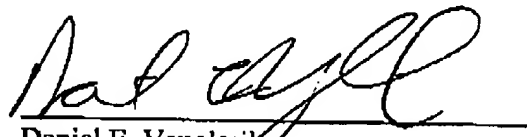
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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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